



#C

PATENT
Docket No. 337462000600
Client Ref. BMID 9619/US

CERTIFICATE OF MAILING BY "FIRST CLASS MAIL"	
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on August 19, 1998.	
August 19, 1998 Date	Tiffany Dolmseth Tiffany Dolmseth

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

MARK M. RICHTER *et al.*

Serial No.: 09/074,472

Filing Date: 07 May 1998

For: ASSAYS EMPLOYING
ELECTROCHEMILUMINESCENT LABELS
AND ELECTROCHEMILUMINESCENCE
QUENCHERS

Examiner: Unknown

Group Art Unit: 1623

PETITION UNDER 37 C.F.R § 1.47(a)

BOX MISSING PARTS
Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

08/27/1998 MPEOPLES 00000008 09074472

04 FC:115

Boehringer Mannheim Corporation, assignee of record of the entire right, title, and interest in and to the above-identified application, hereby petitions the Assistant Commissioner to complete this application on behalf of joint inventor Mark M. Richter (who refuses to execute a declaration in support of this application) under the provisions of 37 C.F.R. § 1.47(a).

08/27/1998 MPEOPLES 00000008 09074472

05 FC:122

130.00 OP

Filed herewith is a "Declaration for Utility Patent Application" (1 page) executed by Michael J. Powell and Christopher M. Belisle. An oath or declaration signed by all the available joint inventors with the signature block of the non-signing inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the non-signing inventor(s), unless otherwise indicated. MPEP § 409.03(a).

Filed herewith is a "Declaration of Facts by Wilhelmus J. Wytenburg" showing the pertinent facts surrounding Mark M. Richter's refusal to execute a declaration in support of this application.

The requisite fee under 37 C.F.R. § 1.17(h) of \$130.00 is filed herewith. The Assistant Commissioner is hereby authorized to charge any additional fees that may be required by this petition, or to credit any overpayment to Deposit Account No. 03-1952 referencing docket number 337462000600.

The last address of Mark M. Richter known to assignee and their appointed representatives is:

Mark M. Richter
5697 S. Wedgewood Avenue
Springfield, Missouri 65810
U.S.A.

The accompanying documents are believed to be in compliance with 37 C.F.R. § 1.47(a). Petitioner requests that the Office grant this petition and accord this application status under 37 C.F.R. § 1.47(a) by accepting the accompanying documents.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Petitioner further petitions for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket number

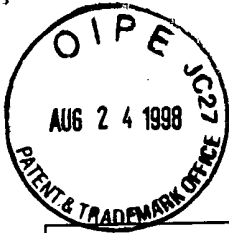
337462000600. However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: August 19, 1998

Respectfully submitted,

By: Gladys H. Monroy
Gladys H. Monroy
Registration No. 32,430

Morrison & Foerster LLP
755 Page Mill Road
Palo Alto, California 94304-1018
Telephone: (650) 813-5711
Facsimile: (650) 494-0792



PATENT
Docket No. 337462000600
Client Ref. BMID 9619/US

CERTIFICATE OF MAILING BY "FIRST CLASS MAIL"

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
Assistant Commissioner for Patents, Washington, D.C. 20231, on August 19, 1998.

August 19, 1998
Date

Tiffany Dolmseth
Tiffany Dolmseth

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

MARK M. RICHTER *et al.*

Serial No.: 09/074,472

Filing Date: 07 May 1998

For: ASSAYS EMPLOYING
ELECTROCHEMILUMINESCENT LABELS
AND ELECTROCHEMILUMINESCENCE
QUENCHERS

Examiner: Unknown

Group Art Unit: 1623

DECLARATION OF FACTS BY WILHELMUS J. WYTENBURG

BOX MISSING PARTS
Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

I, Wilhelmus J. Wytenburg, hereby declare as follows:

1. I am a Patent Legal Analyst employed by Morrison & Foerster LLP, 755 Page Mill Road, Palo Alto, California 94304-1018.

2. I currently assist Gladys H. Monroy, Reg. No. 32,430, and J. Michael Schiff, Reg. No. 40,253, with the prosecution of the above-identified U.S. patent application.
3. On Thursday 11 June 1998, I sent to Mark M. Richter (hereinafter referred to as "Dr. Richter"), by certified U.S. mail, return receipt requested, a package which included:
 - (a) a cover letter (2 pages, copy attached hereto as Exhibit 1);
 - (b) a document entitled "Declaration for Utility Patent Application" (1 page, copy attached hereto as Exhibit 2);
 - (c) a copy of the specification as filed (pages 1-75 and 6 pages of drawings);
 - (d) a document entitled "Refusal to Execute" (1 page, copy attached hereto as Exhibit 3).
 - (e) a copy of the "Assignment" document which had been executed by Dr. Richter on 27 February 1998 (1 page, copy attached hereto as Exhibit 4).
4. The certified mail return receipt was received at Morrison & Foerster LLP on Wednesday 01 July 1998. The receipt indicated that the package had been delivered on Saturday 27 June 1998. The signature on the return receipt appeared to be that of Dr. Richter. A copy of the certified mail return receipt is attached hereto as Exhibit 5.
5. On Friday 17 July 1998, at 11.30 am PDT (1.30 pm local time in Missouri), Mr. Schiff and I, in the Palo Alto office of Morrison and Foerster LLP, spoke by telephone with Dr. Richter, who was at his office at Southwest Missouri State University. His telephone number there is 417-836-5508.
6. Mr. Schiff and I asked Dr. Richter if he had received the package which I had sent him on Thursday 11 June 1998. Dr. Richter stated that he had received the package, and further specifically stated that he had received the cover letter, the "Declaration for Utility Patent Application" document, the copy of the specification as filed (pages 1-75 and 6 pages of drawings), the document entitled "Refusal to Execute," and the copy of the executed "Assignment" document.

7. Mr. Schiff and I asked Dr. Richter if he would execute the "Declaration for Utility Patent Application" document. Mark M. Richter stated that he refuses to execute this document.
8. Mr. Schiff and I asked Dr. Richter if he had a reason for refusing to execute the "Declaration for Utility Patent Application" document. Dr. Richter stated that he was not a lawyer, that he may not understand the legal ramifications of the document, that he was not willing to execute the document without his own independent legal advice, and that he could not afford a lawyer for this advice.
9. Mr. Schiff and I asked Dr. Richter if he would execute the "Refusal to Execute" document. Mark M. Richter stated that he refuses to execute this document.
10. Mr. Schiff and I asked Dr. Richter if the address which appeared on the "Declaration for Utility Patent Application" document was correct. Dr. Richter stated that it was not, that he had moved during the last month, and that his current address was:

Mark M. Richter
5697 S. Wedgewood Avenue
Springfield, Missouri 65810
U.S.A.
11. Mr. Schiff and I asked Dr. Richter if he is a United States citizen. Dr. Richter stated that he is.
12. Later in the afternoon on Friday 17 July 1998, I sent a letter to Dr. Richter, by facsimile, thanking him for taking the time to speak with Mr. Schiff and I, and also forwarding him some additional information which Mr. Schiff and I had offered to provide. A copy of that letter (1 page) and the attachments (4 pages) is attached hereto as Exhibit 6.

13. On Monday 20 July 1998, I received an electronic mail message from Dr. Richter, acknowledging receipt of my letter of 17 July 1998, and stating that his position (refusing to execute the documents) has not changed. A copy of the electronic mail message is attached hereto as Exhibit 7.

14. I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: August 18, 1998

Respectfully submitted,

By: 

Wilhelmus J. Wytenburg
Patent Legal Analyst

Morrison & Foerster LLP
755 Page Mill Road
Palo Alto, California 94304-1018
Telephone: (650) 813-5738
Facsimile: (650) 494-0792

MORRISON & FOERSTER LLP

SAN FRANCISCO
LOS ANGELES
SACRAMENTO
ORANGE COUNTY
PALO ALTO
WALNUT CREEK
DENVER

ATTORNEYS AT LAW

755 PAGE MILL ROAD
PALO ALTO, CALIFORNIA 94304-1018
TELEPHONE (650) 813-5600
TELEFACSIMILE (650) 494-0792

NEW YORK
WASHINGTON, D.C.
LONDON
BRUSSELS
HONG KONG
SINGAPORE
TOKYO

June 11, 1998

Writer's Direct Dial Number
(650) 813-5738

By Certified Mail - Return Receipt

Dr. Mark M. Richter
425 S. Weller Avenue
Springfield, Missouri 65802
USA

Re: U.S. Patent Application No. 09/074,472 filed 07 May 1998
Title: ASSAYS EMPLOYING ELECTROCHEMILUMINESCENT
LABELS AND ELECTROCHEMILUMINESCENCE
QUENCHERS

Inventors: Richter, Powell, & Belisle
Assignee: Boehringer Mannheim Corporation
Our reference: 33746-20006.00

Dear Dr. Richter:

As you may recall, at the request of our client, Boehringer Mannheim Corporation, we prepared and filed on 23 May 1997 a U.S. provisional patent application pertaining to assays employing electrochemiluminescent labels and electrochemiluminescence quenchers, which you co-invented. On 07 May 1998, we filed a U.S. regular patent application pertaining to the same subject matter, and claiming priority benefit under 35 U.S.C. § 119(e) of the earlier provisional application.

The U.S. Patent and Trademark Office has now formally requested that we submit a "Declaration for Utility Patent Application" in connection with this regular application.

In this regard, please find enclosed a document entitled "Declaration for Utility Patent Application" (1 page) along with a copy of the specification as filed (pages 1-75 and 6 pages of drawings). The address which appears on the "Declaration" is that which you provided to me on 07 May 1998. If there are any errors in your name, address, or citizenship, you may make corrections by crossing out the incorrect information, handwriting in the correct information, and initialing and dating the change.

pa-278965

Exhibit 1
to "Declaration of Facts by Wilhelmus J. Wytenburg"
filed in connection with USSN 09/074,472

MORRISON & FOERSTER LLP

Dr. Mark M. Richter
June 11, 1998
Page Two

I would be most grateful if you would review these documents, and, if everything is correct and if you understand and agree with the statements in the "Declaration," please execute the "Declaration" (sign and date, preferably using blue ink) where indicated and return both the executed "Declaration" and the specification to me as soon as possible. For your convenience, a completed Federal Express label and envelope are also enclosed.

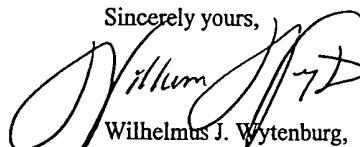
If you refuse to execute the "Declaration" document, I would be most grateful if you would complete, sign and date the enclosed "Refusal to Execute" document (1 page), and return it to me as soon as possible. For your convenience, a completed Federal Express label and envelope are enclosed.

As you will recall, on 27 February 1998 you assigned your entire right, title, and interest in the above-identified invention, including this U.S. regular patent application, to our client, Boehringer Mannheim Corporation. For your convenience, a copy of the Assignment document is enclosed herewith.

As defined in 37 C.F.R. § 1.56, United States patent law places a continuing duty on each individual associated with the prosecution of a patent application to disclose to the Patent Office information that may be material to patentability. These individuals include inventors, their attorneys and agents who prepare and prosecute their patent application, and the application's assignee, to the extent that they are associated with the prosecution. Such "information" includes references (for example, publications, patents, poster presentations, etc.), and information relating to possible prior public use or sale of the invention in the United States, prior invention by another, knowledge derived from others in making the invention, and inventorship conflicts. This duty to disclose information continues throughout the pendency of the application. Accordingly, if you become aware of any information during the pendency of this application, please notify us of it as soon as possible.

If you have any questions, or indeed if I can provide any additional information, please do not hesitate to contact me by telephone at the number listed above, or by facsimile at (650) 494-0794 (note the new area code). I thank you in advance for your time and assistance in this matter, and I look forward to your reply.

Sincerely yours,



Wilhelmus J. Wytenburg,
Scientific Analyst.

Enclosures.

cc: Marilyn Amick, Boehringer Mannheim Corporation

pa-278965

DECLARATION FOR UTILITY PATENT APPLICATION

AS A BELOW-NAMED INVENTOR, I HEREBY DECLARE THAT:

My residence, post office address, and citizenship are as stated below next to my name.

I believe I am the original, first and joint inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled: **ASSAYS EMPLOYING ELECTROCHEMILUMINESCENT LABELS AND ELECTROCHEMILUMINESCENCE QUENCHERS**, the specification for which was filed as U.S. Patent Application No. 09/074,472 on 07 May 1998, and a copy of which is attached hereto.

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims.

I acknowledge the duty to disclose information which is material to the patentability as defined in 37 C.F.R. § 1.56.

I hereby claim benefit under 35 U.S.C. § 119(e) of United States Provisional Application No. 60/047,605 filed 23 May 1997.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment; or both, under § 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date	Name:	Mark M. RICHTER
	Residence:	Springfield, Missouri, USA
	Citizenship:	United States of America
	Post Office Address:	425 S. Weller Avenue, Springfield, Missouri 65802, USA

Date	Name:	Michael J. POWELL
	Residence:	Danville, California, USA
	Citizenship:	United States of America
	Post Office Address:	1024 Ocho Rios, Danville, California 94526, USA

Date	Name:	Christopher M. BELISLE
	Residence:	Concord, California, USA
	Citizenship:	United States of America
	Post Office Address:	1741 Getoun Court, Concord, California 94518, USA

pa-270510

Exhibit 2
to "Declaration of Facts by Wilhelmus J. Wytenburg"
filed in connection with USSN 09/074,472

REFUSAL TO EXECUTE
"DECLARATION FOR UTILITY PATENT APPLICATION"

I, Mark M. Richter, residing at 425 S. Weller Avenue, Springfield, Missouri 65802, USA, hereby indicate that I am unwilling to execute a "Declaration for Utility Patent Application" in support of U.S. Patent Application No. 09/074,472, entitled "ASSAYS EMPLOYING ELECTROCHEMILUMINESCENT LABELS AND ELECTROCHEMILUMINESCENCE QUENCHERS."

Signature: Mark M. Richter

Date

Time

Place (city, state, country)

My reason(s) for being unwilling are as follows:

☐ I am not an inventor of this technology as presently claimed.

☐ Other reasons: *(please specify)*

pa-278982

Exhibit 3
to "Declaration of Facts by Wilhelmus J. Wytenburg"
filed in connection with USSN 09/074,472

ASSIGNMENTAttorney Docket No.: 337463000600
Client Ref. No. BMD 9619/US

THIS ASSIGNMENT, by Mark M. Richter (hereinafter referred to as the assignor), residing at Springfield, Missouri, witnesseth:

WHEREAS, said assignor has co-invented certain new and useful improvements in ASSAYS EMPLOYING ELECTROCHEMILUMINESCENT LABELS AND ELECTROCHEMILUMINESCENCE QUENCHERS, set forth in a provisional application for patent of the United States of America, bearing Serial No. 60/047,605 and filed on 23 May 1997; and

WHEREAS, Boehringer Mannheim Corporation, a corporation duly organized under and pursuant to the laws of Indiana and having its principal place of business at 9115 Hague Road, Indianapolis, Indiana 46250, U.S.A. (hereinafter referred to as the assignee) is desirous of acquiring assignor's entire right, title and interest in and to said inventions, and said provisional application for patent of the United States of America, and in aid to any and all Letters Patent or Patents, United States of America or foreign, to be obtained therefor and thereon:

NOW, THEREFORE, in consideration of One Dollar (\$1.00) and other good and sufficient considerations, the receipt of which is hereby acknowledged, said assignor has sold, assigned, transferred and set over, and by these presents does sell, assign, transfer and set over, unto said assignee, its successors, legal representatives and assigns, assignor's entire right, title and interest in and to the above-mentioned inventions, said provisional application for patent of the United States of America, any and all Letters Patent or Patents in the United States of America or any foreign country which may be granted therefor and thereon, any and all applications for Letters Patent or Patent in the United States of America or any foreign country for said inventions, any and all divisional, continuation, or continuation-in-part applications for Letters Patent or Patent in the United States of America or any foreign country for said inventions, any and all reissues or extensions of any Letters Patent or Patent in the United States of America or any foreign country for said inventions, any and all applications for Letters Patent or Patent in the United States of America or any foreign country claiming priority benefit of said provisional application, and all rights under the International Convention for the Protection of Industrial Property for said inventions, the same to be held and enjoyed by said assignee, for its own use and the use of its successors, legal representatives and assigns, to the full end of the term or terms for which Letters Patent or Patents may be granted, as fully and entirely as the same would have been held and enjoyed by the assignor, had this sale and assignment not been made.

AND for the same consideration, said assignor hereby covenants and agrees to and with said assignee its successors, legal representatives and assigns, that, at the time of execution and delivery of these presents, said assignor is the sole and lawful owner of assignor's entire right, title and interest in and to said inventions and the provisional application for patent above-mentioned, that the same is unencumbered, and that said assignor has good and full right and lawful authority to sell and convey the same in the manner herein set forth.

2/27/98
3/27/98
Date

Mark M. Richter

COPY

pa-215413

Exhibit 4
to "Declaration of Facts by Wilhelmus J. Wytenburg"
filed in connection with USSN 09/074,472

Is your RETURN ADDRESS completed on the reverse side?

SENDER:

- Complete items 1 and/or 2 for additional services.
- Complete items 3, and 4a & b.
- Print your name and address on the reverse of this form so that we can return this card to you.
- Attach this form to the front of the mailpiece, or on the back if space does not permit.
- Write "Return Receipt Requested" on the mailpiece below the article number.
- The Return Receipt will show to whom the article was delivered and the date delivered.

I also wish to receive the following services (for an extra fee):

1. ☐ Addressee's Address
2. ☐ Restricted Delivery

Consult postmaster for fee.

3. Article Addressed to:

DR. MARK M. RICHTER
425 S. WELLER AVENUE
SPRINGFIELD, MISSOURI 65802

4a. Article Number

Z-397-829-286

4b. Service Type

- ☐ Registered ☐ Insured
- ☒ Certified ☐ COD
- ☐ Express Mail ☐ Return Receipt for Merchandise

7. Date of Delivery

6-27-98

6. Signature (Addressee)

6. Signature (Agent)

8. Addressee's Address (Only if requested and fee is paid)

PS Form 3811, December 1991

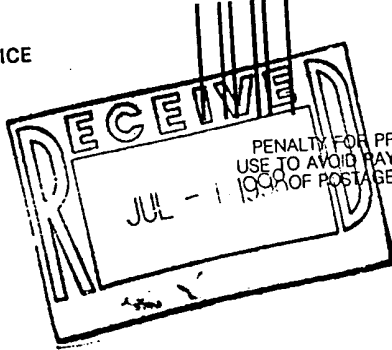
★U.S. GPO: 1993-352-714

DOMESTIC RETURN RECEIPT

Thank you for using Return Receipt Service.

UNITED STATES POSTAL SERVICE

Official Business



Print your name, address and ZIP Code here

W.J. WYTENBURG
MORRISON & FOERSTER LLP
755 PAGE MILL ROAD
PALO ALTO, CA 94304-1018

MORRISON & FOERSTER LLP

SAN FRANCISCO
LOS ANGELES
SACRAMENTO
ORANGE COUNTY
PALO ALTO
WALNUT CREEK
DENVER

ATTORNEYS AT LAW

755 PAGE MILL ROAD
PALO ALTO, CALIFORNIA 94304-1018
TELEPHONE (650) 813-5600
TELEFACSIMILE (650) 494-0792

NEW YORK
WASHINGTON, D.C.
LONDON
BRUSSELS
HONG KONG
SINGAPORE
TOKYO

July 17, 1998

Writer's Direct Dial Number
(650) 813-5738

By Facsimile

Dr. Mark M. Richter
5697 S. Wedgewood Avenue
Springfield, Missouri 65810
USA

Re: U.S. Patent Application No. 09/074,472 filed 07 May 1998
Title: ASSAYS EMPLOYING ELECTROCHEMILUMINESCENT
LABELS AND ELECTROCHEMILUMINESCENCE
QUENCHERS

Inventors: Richter, Powell, & Belisle
Assignee: Boehringer Mannheim Corporation
Our reference: 33746-20006.00

Dear Dr. Richter:

Thank you for taking the time to speak with me and Michael Schiff today, Friday 17 July 1998, at 11.30 am PDT (1.30 pm your time).

Thank you also for providing us with your current home address, shown above.

As promised, please find attached a copy of the model "Declaration" document provided to the public by the Patent Office. This document may be downloaded from the Patent Office website at <http://www.uspto.gov/web/forms/index.html>.

Also as promised, attached is a copy of 37 C.F.R. § 1.56, which is referred to in the "Declaration" document.

Again, I thank you for your time and cooperation in this matter.

If you have any questions, or indeed if I can provide any additional information, please do not hesitate to contact me by telephone at the number listed above, or by facsimile at (650) 494-0794 (note the new area code).

Sincerely yours,
Wilhelmus J. Wytenburg,
Scientific Analyst.

Enclosures.
cc: Marilyn Amick, Boehringer Mannheim Corporation

pa-289014

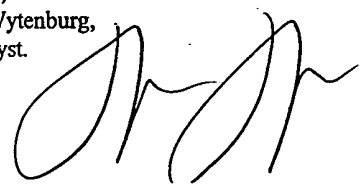


Exhibit 6
to "Declaration of Facts by Wilhelmus J. Wytenburg"
filed in connection with USSN 09/074,472

Please type a plus sign (+) inside this box → ☐

PTO/SB/01 (12-97)
Approved for use through 9/30/00. OMB 0651-0032
Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

**DECLARATION FOR UTILITY OR
DESIGN
PATENT APPLICATION
(37 CFR 1.63)**

☐ Declaration Submitted with Initial Filing OR ☐ Declaration Submitted after Initial Filing (surcharge (37 CFR 1.16 (e)) required)

Attorney Docket Number

First Named Inventor

COMPLETE IF KNOWN

Application Number

Filing Date

Group Art Unit

Examiner Name

As a below named inventor, I hereby declare that:

My residence, post office address, and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

the specification of which

(Title of the invention)

☐ is attached hereto

OR

☐ was filed on (MM/DD/YYYY) as United States Application Number or PCT International

Application Number and was amended on (MM/DD/YYYY) (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment specifically referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.

I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or 365(b) of any foreign application(s) for patent or inventor's certificate, or 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or of any PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application Number(s)	Country	Foreign Filing Date (MM/DD/YYYY)	Priority Not Claimed	Certified Copy Attached?	
				YES	NO
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>

☐ Additional foreign application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto:

I hereby claim the benefit under 35 U.S.C. 119(e) of any United States provisional application(s) listed below.

Application Number(s)	Filing Date (MM/DD/YYYY)	<input type="checkbox"/> Additional provisional application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto.

[Page 1 of 2]

Burden Hour Statement: This form is estimated to take 0.4 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

Please type a plus sign (+) inside this box → ☐

PTO/SB/01 (12-97)
Approved for use through 9/30/00. OMB 0651-0032
Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

DECLARATION — Utility or Design Patent Application

I hereby claim the benefit under 35 U.S.C. 120 of any United States application(s), or 365(c) of any PCT international application designating the United States of America, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT international application in the manner provided by the first paragraph of 35 U.S.C. 112, I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application.

U.S. Parent Application or PCT Parent Number	Parent Filing Date (MM/DD/YYYY)	Parent Patent Number (if applicable)

☐ Additional U.S. or PCT international application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto.

As a named inventor, I hereby appoint the following registered practitioner(s) to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith:

☐ Customer Number

OR

☐ Registered practitioner(s) name/registration number listed below

Place Customer
Number Bar Code
Label here

Name	Registration Number	Name	Registration Number

☐ Additional registered practitioner(s) named on supplemental Registered Practitioner Information sheet PTO/SB/02C attached hereto.

Direct all correspondence to: ☐ Customer Number ☐ OR ☐ Correspondence address below

Name			
Address			
Address			
City	State	ZIP	
Country	Telephone	Fax	

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Name of Sole or First Inventor:

☐ A petition has been filed for this unsigned inventor

Given Name (first and middle (if any))		Family Name or Surname	
Inventor's Signature		Date	
Residence: City	State	Country	Citizenship
Post Office Address			
Post Office Address			
City	State	ZIP	Country

☐ Additional inventors are being named on the _____ supplemental Additional Inventor(s) sheet(s) PTO/SB/02A attached hereto

certain minor informalities may be waived subject to subsequent correction whenever required.

(2) A provisional application for a patent filed under paragraph (b)(2) of this section will not be placed upon the files for examination and will become abandoned no later than twelve months after its filing date pursuant to 35 U.S.C. 111(b)(1).

(f) The filing date of an international application designating the United States of America shall be treated as the filing date in the United States of America under PCT Article 11(3), except as provided in 35 U.S.C. 102(e).

(35 U.S.C. 6, Pub. L. 97-247)

[48 FR 2709, Jan. 20, 1983, as amended at 49 FR 554, Jan. 4, 1984; 50 FR 31826, Aug. 6, 1985; 60 FR 20223, Apr. 25, 1995]

§1.54 Parts of application to be filed together; filing receipt.

(a) It is desirable that all parts of the complete application be deposited in the Office together; otherwise a letter must accompany each part, accurately and clearly connecting it with the other parts of the application. See §1.53 with regard to completion of an application.

(b) Applicant will be informed of the application number and filing date by a filing receipt.

(35 U.S.C. 6, Pub. L. 97-247)

[48 FR 2710, Jan. 20, 1983, as amended at 61 FR 42803, Aug. 19, 1996]

§1.55 Claim for foreign priority.

(a) An applicant in a nonprovisional application may claim the benefit of the filing date of one or more prior foreign applications under the conditions specified in 35 U.S.C. 119(a)-(d) and 172. The claim to priority need be in no special form and may be made by the attorney or agent if the foreign application is referred to in the oath or declaration as required by §1.63. The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) must be filed in the case of an interference (§1.630), when necessary to overcome the date of a reference relied upon by the examiner, when specifically required by the examiner, and in all other cases, before the patent is granted. If the claim for

priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by a petition requesting entry and by the fee set forth in §1.17(i). If the certified copy filed is not in the English language, a translation need not be filed except in the case of interference; or when necessary to overcome the date of a reference relied upon by the examiner; or when specifically required by the examiner, in which event an English language translation must be filed together with a statement that the translation of the certified copy is accurate. The statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office.

(b) An applicant in a nonprovisional application may under certain circumstances claim priority on the basis of one or more applications for an inventor's certificate in a country granting both inventor's certificates and patents. To claim the right of priority on the basis of an application for an inventor's certificate in such a country under 35 U.S.C. 119(d), the applicant when submitting a claim for such right as specified in paragraph (a) of this section, shall include an affidavit or declaration. The affidavit or declaration must include a specific statement that, upon an investigation, he or she is satisfied that to the best of his or her knowledge, the applicant, when filing the application for the inventor's certificate, had the option to file an application for either a patent or an inventor's certificate as to the subject matter of the identified claim or claims forming the basis for the claim of priority.

[60 FR 20224, Apr. 25, 1995]

§1.56 Duty to disclose information material to patentability.

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good

faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

(1) Prior art cited in search reports of a foreign patent office in a counterpart application, and

(2) The closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

(1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the applicant takes in:

(i) Opposing an argument of unpatentability relied on by the Office, or

(ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

(1) Each inventor named in the application;

(2) Each attorney or agent who prepares or prosecutes the application; and

(3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.

(d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.

[57 FR 2034, Jan. 17, 1992]

§ 1.57 [Reserved]

§ 1.58 Chemical and mathematical formulae and tables.

(a) The specification, including the claims, may contain chemical and mathematical formulas, but shall not contain drawings or flow diagrams. The description portion of the specification may contain tables; claims may contain tables either if necessary to conform to 35 U.S.C. 112 or if otherwise found to be desirable.

(b) [Reserved]

(c) Chemical and mathematical formulae and tables must be presented in compliance with § 1.52 (a) and (b), except that chemical and mathematical formulae or tables may be placed in a landscape orientation if they cannot be presented satisfactorily in a portrait orientation. Typewritten characters

Wytenburg, Wilhelmus J.

From: Mark Richter
To: wwytensburg@mofo.com
Cc: Marily_amick@mgc.boehringer-mannheim.com
Subject: Patent Issues
Date: July 20, 1998 1:58PM

To: Wilhelmus J. Wytenburg

From: Mark M. Richter

Date: 07/20/98

Re: Patent Issues

Dear Mr. Wytenburg,

I have briefly reviewed the information that was faxed on Friday, July 17, 1998. My original position has not changed. However, I am willing to agree to spend the necessary time for careful review and signature of all the necessary documents if Boehringer Mannheim is willing to compensate me for my time in this matter. As I indicated during our conversation on Friday the 17th, I am no longer an employee of Boehringer and therefore am not obligated to spend time on projects that are primarily in their best interest and not mine. My present position is quite demanding, and I take my family responsibilities seriously.

Therefore, I am willing to:

1. review the necessary documents for an hourly fee of \$200/hr (or a fee agreeable to both parties) with a maximum value (i.e., a flat rate if the time should go above that for the hourly basis) of \$2000 per document/signature.
2. Negotiate a consulting agreement that states Boehringer Mannheim will pay me a consulting fee of \$200/hour (with a maximum daily fee of \$1600) plus expenses if my expertise is required to defend the patent. I will, of course, require that a maximum or limiting commitment be written into the contract to limit the amount of time I am required to be away from my present work/teaching and my family at any one time.

Please note that the above rates apply to both domestic and international patents and consulting fees.

If at any time I require legal consultation on the documents that I am being asked to sign, I will at my expense seek out legal counsel of my choice. Boehringer will not be charged for the time that it takes to discuss any pending issues with legal counsel, only in the time that I personally am reviewing and signing documents.

These types of arrangements are standard business practice with most firms, and I negotiated several of them during my time with Boehringer.

I will also require a written statement from Boehringer that I may, if I ever find the time to do so, author a publication on work the patent covers.

Please let me know as soon as possible whether this is agreeable to Boehringer so that we may put this issue behind us.

Sincerely,

Mark Richter

P.S. If Boehringer is not willing to agree to some sort of arrangement, I recommend that you either (1) file the patent without my signature or (2) take the issue to court and have the court issue a decree forcing me to sign or to be held in contempt. -MMR

Exhibit 7

to "Declaration of Facts by Wilhelmus J. Wytenburg"
filed in connection with USSN 09/074,472